



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,873	09/23/1999	Stuart Serkin	09857/029001	5264
26161 7590 02/24/2010 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
BUCHANAN, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
3627				
NOTIFICATION DATE		DELIVERY MODE		
02/24/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

09/401,873

Applicant(s)

SERKIN ET AL.

Examiner

CHRISTOPHER R. BUCHANAN

Art Unit

3627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7-12 and 14-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7-12 and 14-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SD-102)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 17, 2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4, 5, 7-12, and 14-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over the NASD reference in view of Korhammer et al. (US 6,278,982) and official notice.

Regarding claim 1, NASD discloses an electronic market collector facility comprising a computer system having an interface to provide a single, common point of entry for coupling a plurality of order delivery systems and quote entry systems that

send quotes to the computer system to the collector facility, a computer program that manages quotes received from the quote entry systems and orders received from the order delivery systems, that manages order routing/execution to provide for all orders received by the interface either a single point delivery of executions or routing of orders in accordance with parameters of the order (FF 14& 15), and that determines if one of the received orders has been executed by the collector facility (p. 11 par. 1, details describing order handling).

NASD does not explicitly show the system to receive a request to cancel execution of one of the received orders, for a market participant to have received one of the orders also in an order book stored in the collector facility as a reason for order cancellation, to cancel the order if the order has not been executed, or to send a message to deny the request to cancel if the order has already been executed.

Korhammer discloses a collector facility for consolidating orders and order book information from multiple sources (see abstract), wherein the system can receive a request to cancel execution of one of the received orders (Fig. 7, 413, cancel message sent to customer, col. 12 line 17-30, determines if order was executed, sends cancel message).

The examiner gives official notice that it would be a well-known matter of logic to either cancel an order or deny a cancel request once a request to cancel an order has been received by a system. Furthermore, there could be a variety of reasons for canceling an order, e.g., insufficient funds available at execution time, specified time limit passed, participant criteria not met, etc. The particular reason for canceling an

order would be a matter of design choice, since this does not affect the nature or functioning of the invention and does not serve any particular purpose or solve any stated problem.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of the NASD reference to receive a request to cancel execution of one of the received orders, as taught by Korhammer, to enable market participants to modify placed orders in response to changing market conditions, and to cancel the order if the order has not been executed or to deny the request to cancel if the order has already been executed wherein there could be various reasons for cancellation, as suggested by official notice and design choice, because combining these well-known features with the other teachings of the prior art would merely yield predictable results.

Regarding claim 4, managing multiple quotes and orders at multiple price levels is shown by the management of the limit order file in NASD, since a limit order file contains multiple quotes and orders at multiple price levels (FF 18). Regarding claim 5, aggregate or current quote montage is shown by the three methods of display in NASD, including montage and full displays (FF 18). Regarding claims 7-12, the particular features of the management of the order routing/execution, i.e., including time stamping, assigning priorities, price levels, etc., would be matters of design choice, since they do not affect the nature or functioning of the invention.

Regarding claims 14-19, the features of the invention recited in these claims have already been addressed in the rejection above. Regarding claims 20-29, the

features of the invention recited in these claims have already been addressed in the rejection above. Regarding claims 30-33, the order manager must either accept or decline the request and the particular criteria required for each option would be a matter of design choice.

Response to Arguments

4. Applicant's arguments filed December 17, 2009 have been fully considered but they are not persuasive. Applicant argues that the prior art, the NASD reference, does not disclose all the recited features of the claimed invention, in particular, allowing a market participant to send a request to cancel an order and either canceling the order or denying the request to cancel. Applicant also argues that the examiner's assertion that the reason for order cancellation is a matter of design choice.

The examiner disagrees and stands by the rejection. The points of applicant's arguments have been addressed in the revised rejection above. Also, the examiner notes that a proper challenge to official notice or design choice requires the applicant to submit a reasoned statement explaining how the examiner's assertion is incorrect and describing the novelty and purpose of the feature in question along with supporting evidence.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone

number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CRB/
Examiner AU 3627

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627